



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,597	06/29/2001	Michael E. Gardi	23952-0143	6502

72386 7590 10/31/2007
SUTHERLAND II
SUTHERLAND, ASBILL & BRENNAN, LLC
999 PEACHTREE STREET
ATLANTA, GA 30309

EXAMINER

OYEBISI, OJO O

ART UNIT	PAPER NUMBER
----------	--------------

3694

MAIL DATE	DELIVERY MODE
-----------	---------------

10/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/893,597

Applicant(s)

GARDI ET AL.

Examiner

OJO O. OYEBISI

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8, 12, 20, 24 and 38-53 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 6, 7, 13-16, 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 12, 20, 24, 38-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Art Unit: 3694

DETAILED ACTION

In response to the restriction requirement mailed 07/16/07, the applicant has elected the invention of Group II (claims 8, 12, 20, 24, 38-53) with traverse. Claims 5, 9-11, 17, 21-23, 25, and 26-37 have previously been cancelled, and claims 1-4, 6-7, 13-16 and 18-19 have been withdrawn from consideration. The examiner contends that Inventions I and II are distinct, and have acquired a separate status in the art because of their recognized divergent subject matter. The applicant's election of Group II (claims 8, 12, 20, 24, 38-53) is hereby acknowledged and the restriction requirement is now final.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 40, 43-49, 51-52, and are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed, does not provide support for the invention as now claimed in claims 40, 45, 48-49, 51-52 supra i.e., wherein the qualification information does not include financial factors associated with the received billing information, historical billing information associated with the customer

More specifically, the specification, as originally filed, does disclose "unlike billing

Art Unit: 3694

systems which target customers for receipt of supplemental information based solely upon financial factors, such as billing history and credit criteria, the methods and systems of the present invention provide automated techniques for billers and others to target customers based upon any information they maintain or have access to about customers." That is to say, the qualification information not only includes financial **factors associated** with the received billing information, historical billing information associated with the customer, but also includes any information they maintain or have access to about customers. Further, the specification, as originally filed, does not provide support for the invention as now claimed in claim 43 supra i.e., receive billing information from a **third processor**. More specifically, the specification, as originally filed, does disclose first and second processor, but not a third processor as now implied in claim 43 supra. Claims 44-47 are rejected because of their dependency from the rejected independent claim 43.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 3694

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 8, 12, and 20, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al (Katz hereinafter, US PAT: 6,055,513) in view of Walker et al (Walker hereinafter, 6,196,458) and further in view of Munsil et al (Munsil hereinafter, US PAT: 5,761,650).

Re claim 38. Katz discloses a method for presenting customer-specific supplemental information with billing information (see the summary of the invention), except for comprising: transmitting a request that includes qualification information associated with at least one supplemental information item to a customer relationship management system; receiving a response to the request that identifies at least one customer that qualifies for presentment of the at least one supplemental information item based on the qualification information; subsequent to receiving the response, receiving billing information for the at least one customer; generating a bill presentation for the at least one customer including at least the received billing information and the at least one the supplemental information item; and presenting the generated bill presentation to the at least one customer. However, Walker discloses transmitting a request that includes qualification information associated with at least one supplemental information item to a customer relationship management system (i.e., central controller, see col.3, lines 50-65); receiving a response to the request that identifies at least one customer that qualifies for presentment of the at least one supplemental information item based on the

Art Unit: 3694

qualification information; subsequent to receiving the response (see col.5, lines 20-40); receiving billing information for the at least one customer (see fig.6 element 102); generating a bill presentation for the at least one customer including at least the received billing information and the at least one the supplemental information item; and presenting the generated bill presentation to the at least one customer (i.e., if the billing items satisfy an upsell offer condition, determines an upsell corresponding to the upsell offer condition, and prints onto the billing statement indicia that specifies the upsell, see col.5 lines 23-40, also see col.7 line 65-col.8 line 40). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Katz, Walker and Munsil to provide responsive, effective information for the upsell determination.

Re Claim 43. Katz further discloses a system for presenting customer-specific supplemental information with billing information, comprising a first processor configured to first 1) transmit a request that includes qualification information associated with at least one supplemental information item to a second processor comprising a customer relationship management system (i.e., fig.3 element 132), and 2) receive a response from the request that identifies at least one customer that qualifies for presentment of the at least one supplemental information item based on the qualification information (see col.16, lines 64-67), 2), then 3) receive billing information from a third processor for the at least one customer subsequent to receiving the response. Katz does not explicitly disclose 4) generate a bill a presentation for the at least one customer including at least the received billing information and the at least one supplemental information item, and 5) present the generated bill presentation to the

Art Unit: 3694

at least one customer. However, Walker discloses 4) generate a bill a presentation for the at least one customer including at least the received billing information and the at least one supplemental information item, and 5) present the generated bill presentation to the at least one customer (i.e., if the billing items satisfy an upsell offer condition, determines an upsell corresponding to the upsell offer condition, and prints onto the billing statement indicia that specifies the upsell, see col.5 lines 23-40, also see col.7 line 65-col.8 line 40). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Katz, Walker and Munsil to provide responsive, effective information for the upsell determination.

Re claims 8, 12, 39. Katz further discloses a method for presenting customer-specific supplemental information with billing information, comprising: receiving billing information associated with a customer of a biller (i.e., billing data, see col.9, lines 20-26); determining that the customer qualifies for presentment of a first supplemental information item (i.e., utilize primary transaction data as factor for offering item of information, see abstract); determining that the customer qualifies for presentment of a second supplemental information item; determining that the first and second supplemental information items are not allowed to be presented together (i.e., the upsell determination may be repeated, or the previously determined second upsell may be offered, see col.26, lines 30-40). Katz does not explicitly disclose generating a bill presentation including at least the received billing information and one of the first and the second supplemental information items (i.e., upsells); and presenting the generated bill presentation to the customer. However, Walker discloses generating a bill

Art Unit: 3694

presentation including at least the received billing information and one of the first and the second supplemental information items; and presenting the generated bill presentation to the customer (i.e., if the billing items satisfy an upsell offer condition, determines an upsell corresponding to the upsell offer condition, and prints onto the billing statement indicia that specifies the upsell, see col.5 lines 23-40, also see col.7 line 65-col.8 line 40). Neither Katz nor Walker discloses the method of prioritizing the supplemental information (i.e., first and second supplemental information). However, Munsil makes this disclosure (see col.3, lines 1-30, see col.2, lines 1-25, also see the abstract). Thus, it would have been obvious to one of ordinary skill in the art to combine Katz, Walker and Munsil to provide responsive, effective information for the upsell determination and to avoid having the customer billing statement exceed the cost of first class postage.

Re claims 20, 24, 44. Katz discloses a system for presenting customer-specific supplemental information with billing information, comprising: a first processor configured to transmit billing information associated with a customer of a biller (i.e., fig.3 element 132); and a second processor configured (i.e., fig.3 element 110) to 1) receive the transmitted billing information (see col.16, lines 64-67), 2) determine that the customer qualifies for presentment of a first supplemental information item (i.e., utilize primary transaction data as factor for offering item of information, see abstract), 3) determine that the customer qualifies for presentment of a second supplemental information item, 4) determine that the first and the second supplemental information items are not allowed to be presented together (i.e., the upsell determination may be

Art Unit: 3694

repeated, or the previously determined second upsell may be offered, see col.26, lines 30-40). Katz does not explicitly disclose 5) generating a bill presentation including at least the received billing information and one of the first and the second supplemental information items (i.e., upsells); and 6) presenting the generated bill presentation to the customer. However, Walker discloses generating a bill presentation including at least the received billing information and one of the first and the second supplemental information items; and presenting the generated bill presentation to the customer (i.e., if the billing items satisfy an upsell offer condition, determines an upsell corresponding to the upsell offer condition, and prints onto the billing statement indicia that specifies the upsell, see col.5 lines 23-40, also see col.7 line 65-col.8 line 40). Neither Katz nor Walker discloses the method of prioritizing the supplemental information (i.e., first and second supplemental information). However, Munsil makes this disclosure (see col.3, lines 1-30, see col.2, lines 1-25, also see the abstract). Thus, it would have been obvious to one of ordinary skill in the art to combine Katz, Walker and Munsil to provide responsive, effective information for the upsell determination and to avoid having the customer billing statement exceed the cost of first class postage.

Claims 40, 49-51. Katz discloses the method, wherein the qualification information does not include financial factors associated with the received billing information, historical billing information associated with the at least one customer, or credit information associated with the at least one customer (i.e., demographic information such as age, sex, family status, location, income, education etc can be used as qualification data to offer upsell to customers see col.10 lines 1-25).

Art Unit: 3694

Re claim 41. Katz further discloses the method of claim 38 except for wherein: the generated bill presentation is an electronic bill presentation; and the electronic bill presentation is presented via a network. However, the generated bill presentation is an electronic bill presentation; and the electronic bill presentation is presented via a network (i.e., computer network terminal, see col.3, lines 62-67). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Katz, Walker and Munsil to provide responsive, effective information for the upsell determination.

Re claim 42. Katz further discloses the method of claim 38, except for wherein: the customer relationship management system is maintained by a biller; the billing information is received from the biller by a bill aggregator; and the generated bill presentation is presented by the bill aggregator. Walker further discloses wherein: the customer relationship management system is maintained by a biller see fig.1); the billing information is received from the biller by a bill aggregator (i.e., a credit card account issuer, see abstract); and the generated bill presentation is presented by the bill aggregator (a credit card account issuer, see abstract). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Katz, Walker and Munsil to provide responsive, effective information for the upsell determination.

Re claims 45, 52. Katz further discloses the system, wherein the qualification information does not include financial factors associated with the received billing information, historical billing information associated with the at least one customer, or credit information associated with the at least one customer (i.e., demographic

Art Unit: 3694

information such as age, sex, family status, location, income, education etc can be used as qualification data to offer upsell to customers see col.10 lines 1-25).

Re claims 46, 53. Katz further discloses the system of claim 43, except for wherein: the generated bill presentation is an electronic bill presentation; and the electronic bill presentation is presented via a network. However, Walker discloses wherein: the generated bill presentation is an electronic bill presentation; and the electronic bill presentation is presented via a network. (i.e., computer network terminal, see col.3, lines 62-67). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Katz, Walker and Munsil to provide responsive, effective information for the upsell determination.

Re claim 47. Katz further discloses the system of claim 43, except for wherein: the customer relationship management system is maintained by a biller, the billing information is received from the biller by a bill aggregator; and the generated bill presentation is presented by the bill aggregator. However, Walker discloses wherein: the customer relationship management system is maintained by a biller (see fig.1); the billing information is received from the biller by a bill aggregator (i.e., a credit card account issuer, see abstract); and the generated bill presentation is presented by the bill aggregator (a credit card account issuer, see abstract). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Katz, Walker and Munsil to provide responsive, effective information for the upsell determination.

Art Unit: 3694

Response to Arguments

Applicant's arguments with respect to claims 8, 12, 20, 24, 38-53 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES TRAMMELL can be reached on (571)272-6712. The fax phone

Art Unit: 3694

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


PRIMARY EXAMINER